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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/227,490    01/06/99    GARD    M    35684.0101(P)

WM51/1025

MATTHEW J. BOOTH  
STRASBURGER & PRICE  
600 CONGRESS AVE  
STE 2600  
AUSTIN TX 78701

EXAMINER

LANEAU, R

ART UNIT

PAPER NUMBER

2674

DATE MAILED: 10/25/00

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

*P.J.*

# Office Action Summary

Application No.  
09/227,490

Applicant(s)

Matthew Davis Gard

Examiner

Ronald Laneau

Group Art Unit

2674



☒ Responsive to communication(s) filed on Jan 6, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-16 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-16 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 2674

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,990,865. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between these two claims is that in the later filed case the third conductor is omitted in the claim at issue. Clearly, applicant is attempting to obtain broader coverage in the claim of the application. Therefore, the infringement of the narrower, issued claim(s) would automatically lead to infringement of the instant, broader claim thereby impermissibly extending the monopoly granted.

However, it is well settled that the omission of an element (or elements) and its (their) function(s) is an obvious expedient if the remaining elements perform the same function as before.

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In re Karlson, 136 USPQ 184 (CCPA 1963). In the present instance, the control device comprising one or more conductor arrays connected to one or more surfaces meaning a first conductor connected to a surface, a second conductor connected to another surface, a converter that translates the movement and a controller that correlates the three-dimensional vector data, ..., all perform the same function as claimed before in the cited patent. Therefore, the omission of the element cited above and its function is an obvious expedient since the remaining elements, i.e. the elements in the claims at issue perform the same function as before.

Thus the controlling fact is that patent protection for the control device, fully disclosed in and covered by the claims of the patent, would be extended by the allowance of the claims in the application; and

As already stated, nothing prevented applicant from presenting the claims in the application for examination during the prosecution of the issued patent.

**3. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-9051, (for formal communications; please mark "EXPEDITED  
PROCEDURE")

**Or:**

Art Unit: 2674

(703) 305-308-6606, (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA.,  
Sixth Floor (Receptionist).

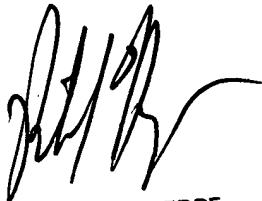
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (703) 305-3973. The examiner can normally be reached on Monday-Friday from 8:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe, can be reached on (703) 305-4709.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Ronald Laneau

October 17, 2000



RICHARD A. HJERPE  
SUPERVISORY PATENT EXAMINER  
GROUP 2700